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KEY TO ABBREVIATIONS

Cal. D. App.	California District Court of Appeals.
D. C. App.	Court of Appeals of the District of Columbia.
Ga. Sup.	Georgia Supreme Court.
Ill. C. C.	Illinois Circuit Court.
La. Sup.	Supreme Court of Louisiana.
Mass. Sup. Jud.	Supreme Judicial Court of Massachusetts.
N. J. Chan.	New Jersey Court of Chancery.
N. J. Sup.	Supreme Court of New Jersey.
N. Y. Sup.	New York Supreme Court.
Ohio C. A.	Ohio Court of Appeals.
Okl. Sup.	Oklahoma Supreme Court.
Ore. Sup.	Supreme Court of Oregon.
Pa. Sup.	Supreme Court of Pennsylvania.
Pat. Off.	Patent Office.
Tex. Civ. App.	Court of Civil Appeals of Texas.
U. S. C. C. A.	United States Circuit Court of Appeals.
U. S. D. C.	United States District Court.
U. S. Sup.	Supreme Court of the United States.
Wash. Sup.	Washington Supreme Court.

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DIGEST

I. TRADE-MARKS GENERALLY.

I, 1. Nature of a Trade-Mark.

I, 1, § 1. *Character of Right.*

d. Source of Right.

An act of sale conveying "all and singular the drug store business known as Bijou No. 5" gave purchasers thereunder the right to use the trade-name "Bijou No. 5" in connection with their business. 8

A trade-mark is not acquired by mere adoption but only by use, and there is no property right in a mark apart from actual use. 32

Any trade-mark or trade-name, not unlawful in itself or against public policy, which has become of pecuniary value or business advantage, becomes property right, and, as such, is entitled to protection. 222

The use by defendants of the name "Skeezix" and picture of a cartoon character as a trade-mark for candy, though prior to such use by plaintiff, *held* contrary to equity and good conscience, inasmuch as the latter was expressly authorized to use such marks by the creator of the cartoon, who had a personal property right therein. 286

I, 1, § 2. *Extent of Right.*

a. As to Territory.

Where, after appellant had adopted and used the words "Sweet Sixteen" as a trade-mark for women's dresses and established five sales shops for same in three cities on the Pacific coast, having also sold by mail some of the goods so marked in Salt Lake City, Utah and circulated catalogues therein, the acts of appellee in starting a similar business in Salt Lake City under the name of "Sweet 16 Shop, Inc." and in registering the said name with the Secretary of State, *held* infringement of plaintiff's mark. 71

The owner of a trade-mark may not, like the proprietor of a patented invention, make a negative and merely prohibitive use of it as a monopoly; hence, its adoption does not project the right of protection in advance of the extension of trade, or operate as a claim of territorial rights over areas over which it thereafter may be deemed desirable to extend the trade. 274

Where plaintiff had since the year 1919 sold flour under the trade-mark "Buttercrust" in western Tennessee, but had never extended its trade therein as far east as Nashville, it could not enjoin the use by defendant of the words "Butter Krust" on bread in and around Nashville and middle Tennessee, inasmuch as there was no competition. 274

b. As to Goods.

Although complainant was first to adopt the words "Society Brand" as a trade-mark for hats, but did not put out felt hats under the mark until the year 1925, it could not, because of such use, enjoin the defendant from the use of the words "Society Club" on felt hats, begun three years previous. 327

A mark which has been registered scores of times must be limited to the species of goods to which it was first applied, and it cannot be extended to all goods sold by owner of mark or even to all goods of the genus, if the latter embraces non-competitive groups. 327

I, 1, § 5. *License to Use.*

Where opposer, whose use of the words "Treasury Bond" as a trade-mark on writing-paper antedated that of applicant, gave the latter permission to use same on the former's goods sold by him under the designation "E.P.C. Treasury Bond," opposer did not thereby part with its title to the said mark. 297

Maker of artificial legs, in selling certain goods and chattels, together with good-will of business in certain described territory, and by agreeing to allow buyer use of trade-name and right to sell on royalty basis for ten years, did not lose exclusive right to name or established business location after expiration of term. 318

I, 2. WHAT MAY BE A TRADE-MARK.

I, 2, § 1. *Color.*

Round red labels attached to lumps of coal, as respects color and shade, cannot be exclusively appropriated as trade-marks. 35

Mere color cannot be appropriated as a trade-mark; and, the plaintiff could not, on the ground of its use of blue color on its egg beaters, deprive defendant from the use of blue on its beaters and boxes, particularly as the respective marks were not confusingly similar, and the use of blue colors for kitchen ware has been long common. 311

I, 2, § 3. *Descriptive and Generic Terms.*
(See also II, 8, § 3.)

Use of name "Sea Fowl," with picture of bird, on bags containing commercial fertilizer, *held* not deceptive or fraudulent, so as to authorize refusal to register trade-mark, in view of evidence that product was known by consuming public as being mixed artificial or manufactured product and not natural fertilizer known as Peruvian guano. 222

I, 3. TITLE TO A TRADE-MARK.

I, 3, § 2. *Assignment and Devolution.*

Grant of exclusive use of trade-mark, limited as to duration and place, does not convey title or establish ownership of trade-mark in licensee or in purchaser of trade-marked goods for resale. 208

I, 3, § 3. *Abandonment.*

While a trade-mark is a symbol selected with the intent to appropriate it to a particular class of goods, and with the hope that it will come to symbolize good-will, the fact that the good-will once associated with it has vanished does not end at once the preferential right of the owner to try it again upon goods of the same class. 159

Where defendant's predecessor first began the use of the word "Beechnut" as a trade-mark for tobacco in 1897, but the use of the mark was discontinued from 1910 till 1915, due to lack of demand, such discontinuance did not amount to abandonment. 159

I, 3, § 4. *Under Trading With Enemy Act.*

The decision of the Supreme Court of Hongkong, granting plaintiff-petitioner injunction restraining defendants from using certain trade-mark in that territory *held* valid, and the decision of the Supreme Court of the Philippine Islands, reversing the decision on the ground that it was in error in holding that the sale of the trade-marks to defendant by the Alien Property Custodian was valid as to exclusive right to use the trade-marks in Hongkong, was reversed, on the ground that the Custodian could convey no rights to marks in English territory valid against those whom the English law protects. 111

Where Federal Trade Commission granted license to use enemy-owned trade-mark, under Trading With the Enemy Act, without seizing property or acquiring title, licensee did not become owner of trade-mark, but only acquired right to use it for limited time on stated royalty, and

could not challenge licensor's power, nor claim that it received more than licensor had power to give. 208

Under Trading With the Enemy Act, where trade-mark was seized by Alien Property Custodian, subject to license to use previously granted by Federal Trade Commission, *held* that Custodian became "owner" thereof and was entitled to recover for its use. 208

On motion for preliminary injunction, where plaintiff claimed the exclusive right to the sale in the United States of an eau de cologne made in Germany by the Muelhens family, said business and good-will having been seized by the Alien Property Custodian and sold to the plaintiff, it was *held* that such seizure and sale did not convey to plaintiff the right to use the secret formula. 425

I, 4. INFRINGEMENT.

I, 4, § 1. *Elements.*

Whether trade-mark infringement exists depends not upon the use of identical words, nor on the question as to whether the two marks are so similar that a person looking at one would be deceived into the belief that it was the other, but it is sufficient if one adopts a trade-name or mark so like another in form, spelling or sound that one, with no very clear recollection as to the real mark, is likely to become confused. 203

Prior user of trade-name is entitled to be protected in his exclusive use thereof against use of deceptively similar trade-name by another, even if such use is in good faith. 335

Infringement of real or trade-name of corporation arises whenever there is such a colorable imitation thereof by another that general public exercising ordinary care might be led to believe that imitation is name of corporation first appropriating same. 480

I, 4, § 2. *Conflicting Marks.*

(See also II, 8, § 20.)

Although defendant, Albert L. Rich, has an undoubted right to use his own name to designate himself in connection with the sale of products, in competition with plaintiff's, it is his duty to avoid confusion insofar as he can do so consistently with such right; and, confusion having arisen, plaintiff's registered mark, consisting of the name "Rich's," *held* to have been infringed. 58

Where the plaintiff and its predecessors were first to adopt and make continuous use in their business of the word "Tecla" as a trade-mark for jewelry, and had incorporated said name in their business title, the use by defendant, Mrs. Tecla Eagle, of the word "Tecla," as a part of her business title, Salon Tecla, Ltd., *held* unfair competition, despite the fact that defendant's business was buying, selling and dealing in cosmetics and various kinds of beauty preparations for women, inasmuch as her use of the word "Tecla" was calculated to deceive. 178

The use by defendant of the word "Peroxygen" as a trade-mark for peroxide of hydrogen, after plaintiff had for many years sold a similar product under its registered trade-mark "Dioxogen," *held* not to have infringed the latter mark, inasmuch as the word "Dioxogen" is descriptive of the goods. 268

Plaintiff having registered certificate from secretary of commonwealth, describing trade-mark used on flour bags as golden dove within circle surrounded by larger circle, with printed words, "Golden Dove," *held* entitled to permanent injunction against competitor using label containing picture of dove identical in form and shape within circle and with similar background, in view of possibility of plaintiff's customers being misled by defendant's mark. 290

That defendants, in using a trade-name imitating plaintiff's registered trade-mark, use a different style of printing, does not necessarily relieve them from being restrained from such use. 335

Where there is a reasonable doubt as to the true interpretation of the idea conveyed by the picture of the girl in a sun-bonnet on a background of the setting sun, the doubt should be resolved in favor of plaintiffs, who first appropriated the idea, used it exclusively for a number of years and registered the words "Sun-Maid" in the Patent Office. 385

Where plaintiff, although claiming use of the word "Pride" as a trade-mark for meat products since the year 1880, used it only in combination with the name "Morrell" and did not register the word "Pride" until the year 1922, it was *held* not entitled to relief on the ground of infringement by the use by defendant of the words "Hauser's Pride" on similar goods, when such use was made prior to the said registration or use of the word "Pride" alone. 411

The use by defendant of the words "Hudson Cord" and "Hudson Super Cord" as trade-marks on automobile tires after adoption and use

by plaintiff of the word "Hudson" and "Hudson Super Six" as trade-marks for automobiles, the latter marks having been duly registered in the Patent Office, *held* an infringement. 459

I, 5. SUITS FOR INFRINGEMENT.

I, 5, § 2. *Parties and Liability.*

Plaintiff corporation, which originally instituted action, although since dissolved, might, nevertheless, become party to the action for the purpose of winding up its business. 178

I, 5, § 4. *Evidence.*

Testimony of merchants handling product that no confusion existed among retail trade because of similarity of labels *held* not conclusive to prevent injunctive relief against use of design similar to that on trade-mark label, where similarity was such that customers might be misled. 290

Similarity of names must be such as to mislead a person of average intelligence. 330

Similarity, and not identity, is the true test of infringement of a trade-mark; the general principle being that imitation should be the same to the eye, or should sound the same to the ear. 335

a. Res Adjudicata.

Whether the doctrine of estoppel by judgment works backwards to bind predecessors in title, as well as forward to bind successors in title, *quaere.* However, the doctrine of *res adjudicata* can find no place where the issues and evidence are different. 363

I, 5, § 5. *Defenses.*

b. Estoppel.

Where plaintiff was first to call a mineral earth sold by him "Kelp Ore," but did not use the words as a trade-mark on his product until after they had come into general descriptive use by others, he acquired thereby no exclusive right to the words. 32

c. Laches.

Where plaintiff promptly protested against the use of infringing labels, but allowed matters to go on on the repeated promises of defendant to discontinue, such laches did not amount to assent or acquiescence. 162

Even though it was shown that several others than defendant had used the word "Tecla" as a part of a trade-name in various lines of business, the law cannot expect plaintiff to sue all infringers at the same time, nor can the failure to bring such actions be construed as acquiescence in infringement or in unfair competition. 178

The fact that plaintiff knew of competitor's use of similar label for 8 or 10 years previous did not bar plaintiff from right to injunctive relief on account of laches; especially where action was commenced almost immediately after plaintiff's registration of his mark. 290

Though laches may bar accounting for profits in suit for unfair competition or infringement, mere laches, in sense of delay to bring suit, will not bar injunction against further continuance of wrong. 291

Preliminary injunction denied to restrain infringement of trade-mark "Coca-Cola" by defendant, by use of the name "Roxa-Cola" for a similar product, where such use has been known to complainant for more than seventeen years before any objection was made. 469

II. REGISTRATION OF TRADE-MARKS.

II, 4. Effect of Registration.

II, 4, § 1. *Act of 1870.*

The registration under the Act of July, 1870, made by appellant of the device of a man falling backward in a fit to be used in connection with the words "Samaritan Nervine" as a trade-mark for nerve tonic, *held* invalid, inasmuch as the said act was later declared unconstitutional. Accordingly, there was no infringement. 82

II, 4, § 2. *Act of 1905.*

Where opposition was made to the registration of the words "Dainty Maid" on the ground of confusing resemblance to the mark "Lady Dainty," already registered under the Act of 1905, applicant's contention that *prima facie* presumption of ownership did not extend beyond the date of registration, *held* unsound, since Congress evidently intended that the owner of a mark should enjoy a continuous presumption of ownership during the life of the registration. 188

Registration of a trade-mark, under Act of February 20, 1905, is merely *prima facie* evidence that person in whose name it is registered is

entitled to the marks, and it is not conclusive or binding on the courts as respects his right to its exclusive use. 396

II, 6. EVIDENCE.

II, 6, § 1. *Res Adjudicata.*

A holding on the question of priority in an equity suit was *res adjudicata* between the parties in a subsequent application to register. 69

II, 8. REGISTRABLE MARKS

II, 8, § 1. *Color.*

Held that applicant is not entitled to register as a trade-mark for pumps the mere coloring of the pump grey uniformly over its entire surface, on the ground that a mark consisting of mere color is not registrable as a trade-mark. 103

A mark for hand drills, 'consisting in coloring the outer and inner faces of the grinding wheel yellow," *held* unregistrable. 343, 442.

II, 8, § 3. *Descriptive and Generic Terms.*

The fact that long use by applicant of the diamond tread design as a trade-mark for its tires had given same a secondary meaning as distinguishing exclusively applicant's tires, did not make the mark registrable, since the statute does not authorize the registration of descriptive marks. 172

The following are *held* to be descriptive:

(See also I, 2, § 3.)

"Speed Wagon," for automobile trucks 11
Diamond tread design, for automobile tires 106, 173
"V-Bar," for greenhouses 117
"Old Dutch," for bread and rusk 132
"Just Right" and "Just-rite," for poultry feed 141
"Rubberset," for brushes 144
"Style Ease," for leather cloth and rubber boots, shoes and slippers 194
"Kant Sag," for bed springs 240
Representation of a rubber and composition heel, for footwear 241
"Everlasting," for blow-off valves 262
"Peroxogen," for peroxide of hydrogen 268

"Jell-Well," for gelatine 278
"Black Band," for coal 303
"The Home Incinerator," for incinerators 349
"Nippy," for mustard 450
"Artistique," for corsets 494
"Multistamp," for stencil hand stamp 553

The following marks are *held* not to be descriptive:

"Wormix," for a powder used to expel worms from domestic animals 90

While the word "Dainty" used alone is descriptive, when used in connection with either the word "lady" or "maid," the general significance of the whole becomes either fanciful or, at most, merely suggestive. 188

II, 8, § 4. *Marks Publici Juris.*

Word "Sun," in common use as a trade-mark in various industries, *held publici juris:* also 190

"Stillson," for pipe wrenches. 255
"Amour," for perfumes. 299
Blue color, for kitchen ware. 311
"Bear," and picture of bear. 361
The word "stripe," for hosiery. 478

II, 8, § 5. *Geographical Terms.*

The following mark was *held* to be geographical:

"Montevallo" 134

II, 8, § 10. *Corporate Names.*

A mark consisting of the word "Goodalls," the letters G and S being larger than the other letters and the tops and bottoms, respectively, of the larger letters connected by a curved line so that these lines and the G and S form an irregular shaped figure enclosing the letters "Oodall," *held* unregistrable. 252

Applicant *held* not entitled to register "Queen Anne" because these words were the essential features of the corporate name of the Queen Anne Candy Co., incorporated prior to the filing of the application. 358

II, 8, § 14. *Emblems of Societies.*

An opposition to the registration of an emblem consisting of the representation of a workman's rule and compass sustained, on ground that it was the emblem of a fraternal organization. 404

II, 8, § 20. *Conflicting Marks.*

A mark consisting of a representation of the Aladdin or Greek lamp with a somewhat peculiar flame or smoke rising from the lamp and having placed beneath the representation the words "The Spice of the Program," and the representation of a conventional seal upon which is shown an Aladdin or Grecian lamp enclosed in concentric circles between which latter appear the words "Lois Weber Productions." 24

A representation of an Indian head, side view, placed upon a disk background, there being the two extremities of three arrows showing at the opposite edges of the disk or circle, and a mark consisting of the representation of an Indian head and shoulders with a portion of a bow above one shoulder and the feathers of the arrows showing behind the opposite shoulder, three feathers being prominently displayed as projecting from the top of the head, and another mark consisting of the words "Indian Head." 192

The following marks are *held* to conflict:

"Lerner Stores" and "Lerner Ladies' Apparel Shop, Inc.".. 4
"Bijou No. 5" and "Bijou Pharmacy" 8
"America" and "Americus" 13
"Riplette" and "Ripleene" 17
"X L-Rub" and "Excel Rub"..... 19
"The Spice of the Program" and "Lois Weber Productions" 24
"Cleveland Opera Company" and "Cleveland Civic Opera Association, Inc." 40
Color, orange yellow with black, and orange yellow with dark blue black 51
"Rich's" and "Albert L. Rich" 59
"Air Ship" and "Zeppelin," each accompanied with picture of airship 65
"Sweet Sixteen Company" and "Sweet '16' Shop, Inc."..... 72
"Worm-X" and "Wormix" 90
"Sixcel" and "Hexcel" 104
"Passaic County Safety Storage Company" and "Safety Storage Company" 120
"John Hay Cadets" and "Cadets" 122
"Big Chief" and "Chief" 124
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"Jell-O" and "Mel-O" 233
"Modern Marriage" and "Marriage" and "Marriage Stories" 235
"Readleaf" and "Redfern" 238
"Every Good Nut That Grows" and "Every Fine Nut That Grows" 282
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"Lysol" and "Lysol-Poison" 474
"Big Ben" and "Big Bill" 493
"Sacony" and "Saxony" 551
"Peer-amid" and "Pyramid" 552

The following marks are *held* not to conflict:

A mark consisting of a picture of a bucket of paint, with a painter in workman's clothes carrying a paint brush in one hand standing therein, together with the word "Bradley's" appearing across the side of the bucket *held* not to conflict with a mark comprising a paint can, with a man in civilian clothes lifting the lid thereof and peering within, together with the accompanying slogan "Look into it," shown on the can, and a

ring of white displaying name of opposing company, with the letters "B P S" visible in the ring on an orange background. 22

The use by appellee as a trade-mark on rusk of a picture of a Dutch windmill scene *held* not to be confusingly similar to appellee's registration of a trade-mark displaying picture of a boy and girl in Dutch costume standing beside a country road, together with the words "Old Dutch," as the words "Old Dutch" are descriptive and the other features of the respective labels are too unlike to cause confusion. 132

"Chieftain," enclosed within a diamond having immediately above the center of the diamond a representation of an Indian in full headdress with a flowing blanket and brandishing a spear, and the representation of an Indian head and bust including full headdress. 151

"Charme d'Amour" and "Fleurs d'Amour" and "Bouquet des Amours" 1, 300
"Dysco" and "Selco" 15
"Grape Nuts" and "Fig-Nuts" 27
"Samoline" and "Sapolin" 67
"Warford" and "Ford" 148
Half disk with radiating lines, indicating rising sun and Indian, and full sun with rays emanating, with laughing human face thereon 154
"Narcisse de Chine" and "Narcisse Noir" 195
"White Oak" and "White Oak Special" 201
"Cordo-Hyde" and "Carbo-Hide" 250, 357
"Buttercrust" and "Butter-Krust" 275
"Bear" and picture of bear and "Bear Salve" and picture of bear 309, 360
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"Stripe" and "Roman Stripe" 478
"Industrial Loan & Finance Company" and "Industrial Investment Company" 480
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"Washington Park" and "Fashion Park" 497
"Fashion Lane" and "Fashion Park" 500
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"United" and "United Drug Company" 556

II, 8, § 21. *Goods of Same Descriptive Properties.*

The following are *held* to be goods of the same descriptive properties:

Cotton or seersucker fabrics composed of cotton and artificial silk; sheer silk piece goods 17
Electrical apparatus of various kinds, comprising rectifiers, transformers, fire alarm systems, timing cutouts, rheostats, telephone receivers, radio parts and accessories and radio receiving sets and parts thereof.....109, 151
Men's and boys' outer shirts, and work shirts 124
Olive oil, and tomato paste 125
Men's, boys', children's and women's garters, and rubber boots, overshoes, woolen boots and socks 137, 493
Sheets, pillow cases, towels and handkerchiefs made of textile fabrics, and cotton piece goods 141
Textile underwear for ladies, and spool silk, stamped linens, braids, dress silks, underwear and hosiery 197
Pancake flour and bread 244
Writing paper and wrapping paper 247, 457
Fresh citrus fruit, and canned fruit and dried fruits 248
Flavoring extracts and baking powder 351
Locks and builders' hardware, and flashlights and batteries 414

Electrical apparatus of various sorts, such as switches, solnoids, electrical motors, electric driven pumps, electric driven pneumatic water systems and internal combustion engines of the smaller types used on farms, mines and in villages for supplying a source of power where electric current is not available, and spark plugs 421
Radio receiving sets, and pianos and player pianos..... 496
Hosiery, and knitted underwear, children's waists..... 552
Sugar wafers and candy 554

The following are *held* to be goods of different descriptive properties:
Cleaning paste for wood, metal, and paints, enamels, varnishes and polishes. 67
Canned fruits, canned vegetables, canned salmon, canned pork and beans, canned evaporated milk, fresh fruits, fresh vegetables, coffee, tea, and macaroni 131
Bread and canned sardines 146
Men's and boys' hats and caps and dresses, capes, coats, suits, skirts, blouses, jacquettes, women's hats, and neckwear, viz., fichus, guimpes, jabots, ruffs and stoles 147
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II, 8, § 22. *Grade Marks.*

The word "Cadets," used on cigars, *held* to perform the function both of a trade-mark and a grade mark, indicating origin as well as size or quality. 122

II, 8, § 23. *Functional Element of Goods.*

The peculiar or special markings constituting the tread of a rubber tire given primarily for the purpose of preventing skidding, *held* to constitute an integral part of the tire and hence unregistrable. 106

"A series of circumferentially disposed outstanding blocks or elements, approximately diamond shaped and spaced by a series of grooves or lines which intersect each other at right angles, the blocks or elements being aligned on parallel cross-planes," used on rubber vehicle tires *held* not to constitute a trade-mark, inasmuch as the alleged mark is a functional part of the tire. 172

Registration of the representation of a rubber and composition heel for footwear, the heel being shown in substantially two equal sections, one being white and the other black, united in a common or unitary article refused. 241

II, 9. For What Goods.

A mark used on the letterheads and billheads of membership association *held* registrable, as indicating origin of goods, rather than membership in the association. 409

II, 10. No Trade-Mark Use.

In a suit for cancellation where it appeared that applicant had made no trade-mark use of the registered mark, the petition was denied. 309

II, 11. Ten-year Clause.

II, 11, § 2. *Interpretation.*

Where it was shown that intrastate use of a trade-mark, consisting of the representation of a mattress, had been made prior to the interstate use of a similar mark by appellant, the latter *held* not to have established a right to register such mark under the ten-year clause of the Act of 1905. 135

II, 11, § 3. *Name of Patented Article.*

Where, several years before appellants applied to register the name "Stillson" under the ten-year clause of the Act of February 20, 1905, alleging actual and exclusive use for the ten-year period, use of the name on pipe-wrenches had been made by a competitor, such registration *held* fraudulent; and appellee's counterclaim for damages was sustained. 255

II, 12. Interferences.

II, 12, § 1. *Declaration.*

The question of descriptiveness cannot be raised in an interference proceeding, since priority of use is the only issue involved therein. 19

II, 12, § 2. *Evidence.*

Where appellant's mark was used by its business predecessor at a date earlier than that claimed by appellee, but said predecessor did not transfer to former the business or good-will, appellant's use *held* to date only from the time it first began such. 19

In an interference the unsupported testimony of aged witnesses testifying to events occurring sixty years before *held* not sufficient to establish priority. 295

II, 12, § 4. *Suspension.*

Petition to suspend was refused where the petitioner had allowed the other party to take testimony without any effort to have the matters complained of adjudicated by court. 26

II, 12, § 5. *Termination.*

a. Dissolution.

Where no motion to dissolve was made during the period set and applicant's time for taking testimony was still running, a subsequent petition to dissolve was properly denied. 502

II, 13. Oppositions.

II, 13, § 6. *Dismissal.*

Where no evidence of any confusion between the respective goods was shown, the opposition was dismissed. 348

II, 13, § 10. *Evidence.*

Where no satisfactory evidence was submitted as to use of mark by opposer, the opposition was dismissed. 200

Where opposer failed to include in list of marks claimed by it, furnished applicant, the mark in dispute, estoppel was *held.* 237

II, 17. Cancellation.

II, 17, § 4. *Pleading and Practice.*

Where opposition was filed to the registration of a mark under the Act of 1920, and, on a holding by the Commissioner that the registration should not be canceled, appeal was had to the Court of Appeals of the District of Columbia, by whom it was dismissed for lack of jurisdiction, a further appeal to the Supreme Court was dismissed on the same grounds,

since that court, being vested with judicial, not administrative functions, has no power to decide on a purely administrative matter under the trade-mark statutes. 27

Motion to dismiss an appeal in a cancellation case was denied, when the appeal showed appealable error, notwithstanding that the Patent Office set the appeal for hearing before proof of service had been received. 62

Where petitioner pleaded prior registration granted him, *held* that judicial notice thereof should be taken. 310

II, 17, § 5. *Evidence.*

A mere allegation of belief of damage *held* insufficient. Facts must appear to show damage would result. 307

II, 20. State and Local Statutes.

II, 20, § 1. *Louisiana.*

Where act of sale conveyed the right to use trade-name, sellers' conduct thereafter in registering trade-name and requesting plaintiffs to desist from use of name, and circulating reports that plaintiffs' use was without legal right, was unwarranted invasion of plaintiffs' legal right to such use. 8

Five hundred dollars damages for wrongfully registering trade-name which plaintiff was authorized to use under written act of sale, and for circulating report that plaintiffs' use thereof was not authorized, *held* not excessive. 8

II, 20, § 2. *Alabama.*

A suit against state commissioner of agriculture and industries to secure registration of trade-mark or trade-name used in sale of commercial fertilizer is not, in effect, a suit against the state. 221

Action of state commissioner of agriculture and industries in refusing permit for registration of trade-mark or trade-name used in sale of commercial fertilizer is subject to judicial control, since he is vested only with quasi judicial function of prohibiting registration and sale of any fertilizer or fertilizer material with misleading or deceptive trade-marks or brand names. 221

II, 20, § 3. *New York.*

Plaintiff, manufacturer of women's and children's hats under the registered trade-mark "Little Darling Hat Company," *held* entitled to enjoin use by defendant, engaged in similar business, of trade-name "Little Miss Dolly Hat Company," notwithstanding pictures used by parties in connection with such names were different. 335

II, 23. Registration by Bill in Equity.

Complainant, a manufacturer of flashlights, dry-cells and storage batteries bearing the trade-mark "Yale," *held* rightly refused registration of mark for said goods, inasmuch as its adoption of the word "Yale" as a trade-mark was shown to have been in order to palm off its goods as those of defendant. 414

III. UNFAIR COMPETITION.

III, 1. Nature and Basis of Wrong.

III, 1, § 1. *Definition.*

"Unfair competition" is conduct of trade or business in such manner that there is express or implied representation that goods or business of one man are goods or business of another. 56

III, 2. Unfairness in Competition.

III, 2, § 1. *Imitating Appearance of Article.*

a. Imitating color.

Equity will ordinarily prevent taxi owner's attempt to appropriate fruits of another's enterprise and labor by copying color combination of his cabs. 50

Injunction *held* to lie to restrain taxi owner from decorating cab in colors massed in same arrangement as that used by another company, which, through long use by latter, had come to signify its cab in public mind, as against objection that mere color is not susceptible of exclusive appropriation. 50

That yellow has greatest visibility of all colors *held* not to warrant decoration of taxicab in same shade of yellow, in same arrangement with other colors, as another company's cabs. 50

III, 2, § 2. *Imitating Structural Elements.*

Where both parties made and sold stoves and heaters, the plaintiff under the name "Heatrola," and defendant under the name "Washington Home Furnace," and where it appeared that the use by defendant of grained mahogany or walnut color in enameling its heaters was shown to be functional and utilitarian, such use did not amount to unfair competition with plaintiff company, whose heaters were similarly enameled, since the latter has no monopoly of size, shape or color. 375

Claim of unfair competition *held* not sustained because defendant used the same material in making a similar product, where there was no evidence of deceit or confusion in the trade. 476

III, 2, § 4. *Imitating Labels.*

Round labels, which defendants attached to lumps of coal and used in advertising, divided horizontally by word "Haco," with "Colorado" above, and "Coals" below in white letters on red background, *held* not deceptively similar to plaintiff's similar labels, having figure of shovel full of coal, through center at angle of 45 degrees, with various slogans in different type than defendants', and, in absence of evidence of fraud or loss of business, due to confusion caused thereby, will not be enjoined. 35

Infringing label must be likely to deceive ordinary observer exercising ordinary care, and eye is best test of this. 35

Where labels and containers of the parties, used on their respective preparations, were distinct and dissimilar in respect of color, wording, form and general appearance, *held* that there was no cause of action and the decision of the lower court dismissing the bill was affirmed. 82

Defendants in copying the main features of plaintiff's label used on confectionery, including trade-marks, color and general appearance, were rightly enjoined from further use of the infringing labels. 162

Where plaintiffs, a cooperative association comprising seventy-five per cent. of the entire raisin-growing industry of California, had adopted and used for fifteen years a trade-mark consisting of the picture of a curly-haired girl wearing a red sun-bonnet, displayed on a red background with a picture of the sun, and the words "California Sun-Maid Seedless Raisins" thereon, the subsequent use by defendants, also growers of raisin grapes, of a similar label closely resembling plaintiffs in color,

pictorial devices and lettering and bearing thereon the words "Sun-Rayed Raisins, Grown Without Seeds," was unfair competition. 385

III, 2, § 5. *Substitution.*

Where plaintiff had used a trade-mark on a substitute article so as to lead the public to believe that such article was the original one, long identified with the mark, it was *held* unlawful use of the mark. 425

Defendant, a retail druggist, in putting up and selling in other than the original containers plaintiff's product, "Lysol," with certain changes in the proportion and character of the original ingredients, but under the original trade-mark, *held* to be unfairly competing with latter. 474

III, 2, § 6. *Names.*

a. Personal Names.

After plaintiff, a corporation made up of three brothers named Lerner, had established and popularized by nearly twenty years of use and advertising the name "Lerner" in connection with chain stores selling women's apparel, the defendant, by appropriating and featuring the same name in a competing business, *held* to have invaded the former's rights, and the decision of the lower court refusing to grant an injunction was reversed. 3

Plaintiff, who acquired right to use trade-name of brother, a maker of artificial legs, for ten years, *held* properly enjoined at expiration of period from using name in manufacturing and selling legs, in business location or in connection with telephone service, and from using brother's letterheads and catalogs. 319

The principle that "no man has a right to represent his goods as the goods of another," is applicable to misrepresentations by the use of a proper name, as well as by other means, even though the name be one which the defendant would ordinarily have a right to use. 363

Defendants, who had used the name "Tierney" on lunch wagons and made same well known as a trade-name therefor, by using the same name in a competing business after the sale to plaintiff of the original business and good-will, and by soliciting plaintiff's customers in such a way as to lead them to believe they were dealing with the original firm, *held* guilty of unfair competition, and a preliminary injunction was issued. 434

b. Corporate Names.

Defendant's name, the Cleveland Civic Opera Association, Incorporated, *held* to be so substantially similar to plaintiff's name of the Cleveland Opera Company that use thereof would amount to unfair competition. 39

Everyone has the absolute right to the use of his own name honestly in his own business and has the right to permit its use by a corporation with which he is connected, but the corporation on whom the right is conferred will not be permitted to resort to any artifice in connection with its use so as to induce the public to believe that its products are products of another established company, engaged in a similar business, and rightfully using the same individual's name. 96

Plaintiff, president of the Sociedad Mutualista Mexicana, an unincorporated association operating in the Mexican colony in the city of New York, *held* entitled to a judgment restraining defendant, its officers and members, from using the list of members of plaintiff's association for any purpose whatsoever, and from engaging in any activities under the name of the association, where it appears that those responsible for the organization of the corporation, whose name is identically similar to that of plaintiff association with the exception of the abbreviation "Inc.," sought to appropriate the good name of the association and pursue a course of action calculated to embarrass, not only the association, but the public generally. 231

The use by defendant, a fur dealer in the city of Dallas, Tex., of the name "Hudson Bay Fur Company" on his place of business *held* a deception of the public and a trespass on the plaintiff's right to the exclusive use of its name, and further use thereof by defendant was enjoined. 270

Where, after plaintiff had built up a large business in electrical apparatus, particularly lighting and pumping outfits, under the name "Duro," and had registered same as a trade-mark in the Patent Office, the subsequent adoption and use of the same word by defendant as a trade-mark for spark plugs, *held* unfair competition, and an injunction was ordered. 420

Plaintiff, which first began to do a general garage business under the name Hudson Taxicab Company, and later began a tire repair business, by changing its name to "Hudson Tire Co., Inc.," and by displaying the words "Hudson" and "Super" on its tires, was unfairly competing with

plaintiff company, which was first to adopt and use the words "Hudson" and "Super" on its automobiles, in spite of the fact that defendant's original use of the word "Hudson" antedated the incorporation of the plaintiff company. 459

III, 2, § 7. *Descriptive Terms.*

The French terms, "Bouquet des Amours," "Fleurs d'Amour" and "Nuit d'Amour," used as trade-marks on perfumes, are vaguely descriptive of a languorous mood, and do not, therefore, *prima facie* denote origin. That they have come to be identified solely with the product of a certain manufacturer is a matter for strict proof. 1

There can be no monopoly in trade-names of words geographical or descriptive. However, words geographical or descriptive are not barred in a trade-name, unless in connection with other words they are precisely or so substantially similar that deception would arise. 39

If a trade-name consists of descriptive word, no monopoly of the right to use can be acquired and others may use it provided they take the proper steps to prevent deception of the public. However, if such name is used by a "later comer" so that there is a likelihood that the public will be deceived and no sufficient steps are taken to prevent such deception, the "earlier comer" is entitled to protection. 82

Defendant by adopting and using for his valves the word "Ever-tight," after plaintiff created for his valves a wide demand under the trade-mark "Everlasting," *held* not to be unfairly competing with the latter, inasmuch as both words are descriptive, and there was no evidence that any of plaintiff's customers were deceived. 262

Even generic names and emblems on product will be protected if there has been such prior combination and association of them with, and application of them to, new and distinctive enterprise that their subsequent use by others would tend to mislead public and injure association first so using them. 487

III, 2, § 11. *Trade Secrets.*

Discoverer of secret formulas for manufacture of medicine may prevent disclosure by ex-employee contrary to his agreement, though they be not in writing or protected by copyright, patent, or registered trade-mark, notwithstanding that such formulas may not have constituted property, within Const. Art. 12, § 6. 487

III, 2, § 19. *Other Instances*

Foundation of action for unfair competition may consist of conduct by defendant of such persistent and continuous nature as has resulted in damage to plaintiff in production and sale of its wares. 56

Malicious acts by way of litigation in courts not founded on good faith but to harass and injure rival producing and selling same commodity, may authorize recovery as for unfair competition. 56

The sale by defendant of diluted "Coca-Cola" syrup as and for the genuine *held* enjoinable by preliminary injunction. 95

All practices between business rivals which tend to engender unfair competition are odious to the law and will be restrained by the courts. No man will be permitted to make use of signs or tokens which serve to confuse the identity of his business with that of another so as to mislead the public and divert business from his competitor to himself. 96

Bill complaining that defendant falsely represented that safes sold by it had explosion chambers, whereby public was led to purchase such safes as safes containing an explosion chamber, such as manufactured and sold by plaintiff, *held* insufficient to state cause of action for unfair competition; there being no showing that customers, if they had known representations were false, would have purchased from plaintiff, rather than from other competitors. 114

Where it was shown by scientific experiment that samples of defendant's perfumes sold as plaintiff's, were not the genuine "Narcisse Noir" perfumes, decree was rendered in plaintiff's favor. 118

Despite the fact that the words "Eternit" and "Permanit," both used on asbestos shingles, are dissimilar in sound, except for the final syllable, and unlike in meaning, except as indicating the durable nature of the goods, the fact that defendant sold and invoiced its shingles as "Eternit" shingles justified the belief that it did so for the purpose of profiting from plaintiff's business. 168

The use by petitioner, for many years engaged in the manufacture and sale of mattresses, as a trade-mark of a pictorial representation of a mattress, showing same enclosed at one end and open and expanded at the other in such a way that the expanded portion rose thirty-five inches or more above the other portion, whereas the actual enlargement was

from three to six inches, *held* not to tend to deceive the average purchaser, inasmuch as such representation was regarded as merely fanciful and was not intended to be descriptive; moreover, there was no evidence of purchasers having been deceived thereby. 183

The manufacture of toys in replica of common objects is open to anyone; consequently, similarities in form and appearance are unavoidable, and such confusion as may result is inherent in the right to compete at all. 218

Plaintiff, a manufacturer of children's toys made in replica of automobile trucks, express wagons, steam derricks, etc., sold under the trade-mark "Buddy 'L'," *held* without right to enjoin a competitor from the sale of similar toys made also in replica of familiar objects under the name "Sturditoys," since the coloring, trade-marks and makers' names on each were strikingly different, the only resemblances being those arising from the manufacture in replica of the same objects. 218

Where, after appellant had adopted and made distinctive of his retail nut business the trade-mark "Cash's Mee-Tee Nuts," the slogan "Every Good Nut That Grows," and the colors orange and blue, appearing on his store fronts, the adoption by appellee of the mark "Steinbook's Tas-Tee Nuts," the slogan "Every Fine Nut That Grows," and the same color scheme for his retail nut and candy stores clearly was in violation of appellant's property rights and constituted unfair competition. 281

Plaintiff who acquired right to use trade-name of brother, who made artificial legs, for ten years, *held* properly enjoined at expiration of period from representing that he was manufacturer of artificial limbs awarded gold medal at International Exposition of Artificial Limbs in London in 1915. 319

Plaintiff should not be restrained from making leg in imitation of that made by brother, since all artificial legs are imitations of human leg, and therefore imitations of each other, nor from using his own name in so doing. 319

Where defendant sent circulars to plaintiff's customers, stating that in proceedings in the Patent Office it had been awarded exclusive right to a certain trade-mark, which it had registered under Act of February 20, 1905, and notifying them to desist from sale of any material infringing its rights, *held,* that plaintiff's application for preliminary injunction to

restrain defendant from continuing such intimidation will be denied, where, though defendant exaggerated scope of Patent Office decision, exaggerations were not gross, and plaintiff had offended similarly, and where trial of issues might disclose that either party has exclusive right to trade-mark, or that acquiescence or estoppel of either permits continued use thereof by other. 396

From letters and circulars sent out by defendant to complainant's customers, in which misuse was made of a default decree for infringement of a patent, obtained by defendant against a customer of complainant, and containing threats of suit, whereas no suit involving the validity or infringement of the patent had ever been tried, *held* unfair competition. 430

III, 3. Suits for Unfair Competition.

III, 3, § 1. *Jurisdiction.*

Where both parties were citizens of the same state, the issue of unfair competition was not considered, the court being without jurisdiction. 268

III, 3, § 2. *Parties and Liability.*

Where defendant, knowing that plaintiff manufactured and sold "Woodbury Facial Soap," so dressed his soap, which was made by him and delivered to Woodbury, as to be likely to deceive purchasers and to come into unfair competition with plaintiff's product, then he (defendant) is liable as a contributory infringer. 363

III, 3, § 4. *Evidence.*

Where it is sought to establish right to words vaguely descriptive as trade-marks, affidavits are especially unsuited. Cross-examination is of the essence when issue is of added significance words of colloquial speech may acquire by advertising. 1

In suit to enjoin use of name similar to plaintiff's, evidence must be of strong and convincing nature on question of probability of confusion. 39

III, 3, § 5. *Defenses.*

a. Plaintiff's Misconduct.

Where the specifications respecting the acts committed in obtaining an illegal registration were stated in the answer, plaintiff was fully

advised as to the basis of defendant's claim of fraud, without the necessity of repeating same in the counter-claim. 255

b. Laches.

When plaintiff delayed action for more than a year after filing bill, defendant was justified in assuming that no immediate action was in mind. The latter, having in the meantime built up his business, was not to be interfered with until plaintiff had completed his case. 1

The substitution by defendant of a beechnut for a squirrel in its label and using an oval frame, both in prior use by plaintiff, might have required, on a prompter challenge, a clearer indication on defendant's label had plaintiff not waited six years before bringing action. 159

III, 3, § 6. *Relief.*

Where an injunction is had against unfair competition, wilfully conducted by defendant with knowledge of plaintiff's rights, an accounting normally follows. 162

b. Injunction.

An injunction *pendente lite* will be denied in an action by the owner of chain stores to restrain the defendant from entering the employ of a competitor, since it appears that, while the defendant was employed by the plaintiff under a contract which provided that defendant would not divulge any business methods or trade secrets and would not enter the employ of a competitor for five years after the termination of defendant's services, the defendant was employed by a competitor as a branch manager; that there were no trade secrets or secret formulas which defendant could reveal; that the defendant's services are not unique; and that the defendant did not enter the employ of plaintiff's competitor in the same city in which he worked for the plaintiff as branch manager. 338

d. Damages.

Where plaintiff sold artificial legs in unfair competition with brother, after expiration of period in which he had right to use brother's tradename and sell brother's product, he will not be required to account for profits and damages during such period, in view of impossibility in determining portion attributable solely to wrongful use of name. 319

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